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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,234	09/15/2003	Mei-Hsiang Lai	13934 B	3752
36672	7590	12/28/2004	EXAMINER	
CHARLES E. BAXLEY, ESQ. 90 JOHN STREET THIRD FLOOR NEW YORK, NY 10038			JOHNSON, JERROLD D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/663,234

Applicant(s)

LAI, MEI-HSIANG

Examiner

Jerrold Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims have not been cleaned up subsequent to a translation to the English language and are replete with grammatical errors and claimed elements that have no antecedent basis. Correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 3-5, and 7-9, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Billings, US Patent 5,242,050 in view of Chen, US Patent

5,826,719, and further in view of Sosa, US Design Patent Des. 226,147, and further in view of Mitchell et al., US Patent 1,958,587.

Billings discloses a tool box comprising: a box, an upper cover in half elliptic shape with a concaved space internally, some portion of the brink on the bottom of said upper cover links to said box to open and close, several indentation slots are formed internally to said upper cover; a handle, a collecting plate in an independent tray structure and on said loading area inside said box.

Billings does not disclose: the half ball shape, or the half elliptic shape; the indentation slots in different sizes and shapes on the upper cover; the particular handle configuration of a handle passing through the top of said upper cover, two shafts, two feet, and vertical long holes disposed on the two feet; and, several indentation slots in different sizes and shapes on the collecting plate.

With respect to claim 1, Chen teaches the use of the indentation slots in different sizes and shapes on the upper cover, and several indentation slots in different sizes and shapes on the collecting plate. Sosa discloses the half ball shape and half elliptic shape; and Mitchell discloses the handle configuration of a handle passing through the top of said upper cover, two shafts 19 fixed on the upper cover, two feet 16 and 17 having a vertical long holes within which the shafts are disposed.

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the toolbox of Billings with the well known concept of providing indentation slots in different sizes and shapes on the upper cover, and several indentation slots in different sizes and shapes on the collecting plate as taught by Chen

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so as to allow the toolbox to provide organized storage for various shaped tools. It further would have been obvious at the time of the invention to one of ordinary skill in the art to modify the toolbox of Billings with the well known concept of making the toolbox in an aesthetically desirable shape such as a football having an elliptic shape, as is taught by Sosa, as to do so provides a distinction in the marketplace. It further would have been obvious at the time of the invention to one of ordinary skill in the art to modify the toolbox of Billings with handle of Mitchell, as the handle is moveable vertically providing additional aesthetic benefits to the toolbox.

With respect to claim 3, Billings discloses such a fastener.

With respect to claim 4, Billings discloses such a hinge.

With respect to claim 5, Billings does not disclose a handle container located on the center of the top wall of the upper cover. Mitchell discloses two slots in the upper cover 11 and 12 which serve as handle containers.

With respect to claim 7, Billings does not disclose several slots on said collecting plate in various sizes and shapes as sleeve slots, tool slots, and wrench slots. Chen does teach several slots on said collecting plate in various sizes and shapes as sleeve slots, tool slots and wrench slots.

Again, It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the toolbox of Billings with the well known concept of providing indentation slots in different sizes and shapes on the collecting plate as taught by Chen so as to allow the toolbox to provide organized storage for various shaped tools.

With respect to claim 8, Billings does not disclose the internal brink of said upper cover corresponding to said sleeve slots being concaved for definite depth to make the upper level flat when is closed.

Chen discloses this arrangement.

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the toolbox of Billings with the well known concept of providing the internal brink of said upper cover corresponding to said sleeve slots being concaved for definite depth to make the upper level flat when is closed, as the toolbox might not close properly if a tool is out of its indentation slot otherwise.

With respect to claim 9, Billings does not disclose the indentation located across over said wrench slot of said collecting plate for users to take the wrench out easier.

Chen discloses this configuration on his collecting plate.

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the toolbox of Billings with the well known concept of providing an indentation located across over said wrench slot of said collecting plate. Such a modification is desirable as such a configuration allows users to take wrenches out easier.

Claim 2, as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Billings, US Patent 5,242,050 in view of Chen, US Patent 5,826,719, and further in view of Sosa, US Design Patent Des. 226,147, and further in view of Mitchell et al., US Patent 1,958,587, and further in view of Huang, US Patent 6,375,007.

Billings as modified by Chen Sosa, and Mitchell does not disclose at least one protruding positioning piece located on the top edge of said box, at least one positioning indentation are on the bottom edge of said upper cover, when said upper cover closes, said protruding positioning piece wedges into said positioning indentation.

Huang discloses elements 38, 39, 48, 49 which are: "protruding positioning pieces located on the top edge of said box, at least one positioning indentation are on the bottom edge of said upper cover, when said upper cover closes, said protruding positioning piece wedges into said positioning indentation."

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the toolbox of Billings as modified by Chen Sosa, and Mitchell with the protruding positioning pieces located on the top edge of said box, at least one positioning indentation are on the bottom edge of said upper cover, when said upper cover closes, said protruding positioning piece wedges into said positioning indentation as are disclosed by Huang, as such a structure is known to improve the closure integrity of the toolbox.

Claim 6, as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Billings, US Patent 5,242,050 in view of Chen, US Patent 5,826,719, and further in view of Sosa, US Design Patent Des. 226,147, and further in view of Mitchell et al., US Patent 1,958,587, and further in view of Official Notice.

Billings as modified by Chen Sosa, and Mitchell does not disclose the inward concaved finger slots.

It is known to those of ordinary skill in the art to provide finger slots to trays that are nested within another tray to make it easier to separated and remove an upper tray. Therefore, it would have been obvious at the time of the invention to on of ordinary skill in the art to modify the toolbox of Billings as modified by Chen Sosa, and Mitchell with inward concaved finger slots to assist in the removal of the collecting plate.

Claim 10, as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Billings, US Patent 5,242,050 in view of Chen, US Patent 5,826719, and further in view of Sosa, US Design Patent Des. 226,147, and further in view of Mitchell et al., US Patent 1,958,587, and further in view of Chen US Patent 5,788,072 and Lin, US Patent 5,868,251.

Billings as modified by Chen Sosa, and Mitchell does not disclose the round bar each located on one of said indentation slots to insert screw drive tip.

It could probably be argued that the claim, as written reads on Chen, US Patent 5,826719. However, Chen in US Patent 5,788,072 explicitly shows a round indentation in both the cover and the collecting tray. Lin, US Patent 5,868,251, discloses that screw tip drives are disposed in round tray structures.

It would have been obvious at the time of the invention to on of ordinary skill in the art to modify the toolbox of Billings as modified by Chen Sosa, and Mitchell with the a round indentation (round bar) to accommodate a round screw tip drive container such as is shown by Lin, as such tools are in heavy use.

With respect to claims 11 and 12, Billings does not disclose the elliptic shape on the bottom of the inner wall of the box.



Sosa discloses this elliptic shape on the bottom of the inner wall of the box.

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the toolbox of Billings with the well known concept of providing the box with a football shape as taught by Sosa, and thus provide the elliptic shape on the bottom of the inner wall of the box, as claimed, as such an aesthetic shape is known to be desirable in the market place.

Claims 13, as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Billings, US Patent 5,242,050 in view of Chen, US Patent 5,826,719, and further in view of Sosa, US Design Patent Des. 226,147, and further in view of Mitchell et al., US Patent 1,958,587, and further in view of Lazo de la Vega, US Design Patent Des. 231,586.

Billings as modified by Chen Sosa, and Mitchell does not disclose the several protruding stands on the box.

Lazo de la Vega teaches the use of protruding stands on the box portion.

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the toolbox of Billings as modified by Chen Sosa, and Mitchell, with the entire football shape and the protruding stands of Lazo de la Vega as such a shape is a complete likeness of a football (i.e. is not truncated as was Sosa) and includes protrusions as stands will improve the aesthetic qualities of the toolbox.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jdj



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